

REMARKS

Claims 1-7 are pending in the present application. Claim 8 was cancelled without prejudice in a Preliminary Amendment dated March 8, 2006. In the above referenced Non-Final Office Action the Examiner has made the following actions as further described below.

Claim Rejections

The Examiner has rejected claims 1-7 in the manner discussed below. Applicant respectfully traverses.

Claim Rejections Under 35 U.S.C. § 112

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 112 as assertedly being indefinite. In reply, Applicant has amended claims 4 and 5 to further clarify the assertedly indefinite limitations.

Claim Rejections Under 35 U.S.C. § 102

The Examiner has rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Walker et al., United States Patent No. 5,862,223.

Walker Reference

Walker describes an expert matching method and apparatus for matching an expert having particular qualifications and an end user seeking a solution to a question or request provided to the expert, as well as managing communications between the end user and the

expert and facilitating payment for services rendered by the expert [Abstract, Col. 6, line 55 – Col. 8, line 46].

Differences Between Walker and the Present Invention

Aspects of the present invention as are described in, for example, claim 1 and the associated dependent claims 2-7 (as amended), relate to a double blind method for eliminating actual and potential bias from a malpractice claim evaluation. In one element, in order to facilitate elimination of bias, facts provided by a retaining entity are redacted by a third party so as to prevent identification of any party involved in or having an interest in the claim by an expert retained to evaluate the claim. In addition, a further redaction step is described whereby the third party further redacts, from a written claim evaluation provided by the expert, any information which would permit identification of the expert. The Examiner asserts that Walker teaches such steps, citing Col. 9, lines 66 and 67 and Col. 10, lines 1-7. These lines of Walker, which are in the “Summary of the Invention” section, read:

The ability to provide anonymity to the end user and expert is another advantage of the present invention. The Exchange can provide full or partial anonymity (e.g., providing no information about the expert, or representing only that he is a member of a specific professional organization) because it acts as a trusted third party messenger between the two parties. It can conceal the identity of both people using very simple or very complex techniques depending on the level of security required.

Successive sections of Walker further clarify that this anonymity relates only to preventing the end user and/or expert from knowing the identify of each other [*e.g.*, Col 10, lines 8-19]. As such, Walker merely suggests that it may be desirable to prevent the expert

from knowing the identify of the end user (*i.e.*, retaining party) and/or preventing the end user from knowing the identify of the expert. Walker, however, goes no further than this, and says nothing regarding how such privacy is implemented other than that the names of the end user and/or retaining party may be withheld from each other [Col. 10, lines 19-26]. More particularly, Walker says absolutely nothing about processing or editing the supplied information (*i.e.*, information as described and cited by the Examiner in Col. 7, lines 6-29) or specifically the third party redacting the supplied information to remove information permitting the expert from identifying any party involved in or having an interest in the claim. This limitation clearly goes beyond the limited scope of the disclosure in Walker in that it involves processing of the received information (*i.e.*, redaction), and the scope of the redaction is such that the identities of any party having in interest in the claim are removed (as opposed to Walker, which merely suggests optionally omitting the identity of the end user or expert). In addition to saying nothing regarding providing anonymity of any party, Walker also fails to describe anything regarding the claimed step of the third party redacting information from the written claim evaluation that would permit identification of the expert. Applicant has reviewed the disclosure of Walker and is unable to find any description or suggestion of third party redaction or any similar type of processing of information provided to or from an expert.

Moreover, while the present invention teaches maintaining anonymity of the expert to provide a double-blind evaluation, Walker describes that identifying the expert and/or facilitating direct contact between the end user and the expert is desirable [*e.g.*, Col. 7, lines 58-61 (“user is offered the opportunity to review the expert’s qualifications”), Col. 8, lines

5-8 (“the user will typically know the experts’ names but not their location or phone numbers”), Col. 8, lines 50-51 (describes an implementation with “the ability for the user to select from a particular list of experts prior to submitting his request”). As such, Walker teaches away from the present invention by suggesting that it is frequently desirable to allow the end use to know the identity of experts and/or have the ability to select a particular expert prior to engaging the expert, and/or allow the end use to directly contact the expert.

For at least these reasons, Applicant respectfully submits that Walker fails to describe all elements of claim 1, and therefore asserts that the rejection of claim 1 under 35 U.S.C. § 102 is improper. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn and the claim be allowed.

Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 2-7 under 35 U.S.C. § 103 as being unpatentable over Walker and *Liebig-Grigsby v. U.S.*, 2003 U.S. Dist. LEXIS 3682 (2003) (“Liebig”) in view of Medical Experts & Established Standards of Care in Malpractice Cases (“Medical Experts”).

For at least the reasons described previously with respect to the 35 U.S.C. § 102 rejection of claim 1, Applicant respectfully submits that the rejections of dependent claims 2-7 (as amended) are improper, and therefore Applicant requests that the rejections be withdrawn and the claims be allowed.

In addition, one aspect of the present invention as is described in, for example, claim 2, relates to a third party acquiring a set of facts which are sufficient to permit an independent evaluation of a claim, with the acquired set of facts including a plurality of (a) facts and documents that relate to the claim, (b) background information about the party asserting the claim, (c) background information about the party against whom the claim is asserted, and (d) facts about the party's peer group in the same geographic area.

The Examiner acknowledges that Walker is deficient with respect to these elements and cites Medical Experts to attempt to cure this deficiency. Medical Experts is an overview of the role of expert witnesses and qualification of expert witnesses in a trial context. As such, Medical Experts describes certain aspects of legal standards used by expert witnesses in trial testimony, but Medical Experts fails to describe anything about specific steps or analysis used by such expert witnesses to evaluate medical conditions. Medical Experts also fails to describe anything about information that might be collected by an expert witness in performing such an evaluation. Moreover, Medical Experts says absolutely nothing about a third party (*i.e.*, a neutral, non-expert party) acquiring such information or distributing such information to the expert witness.

In addition, the description of what constitutes an "expert" in Walker, *i.e.*, one of a group of experts that may be selected based on a user supplied criteria in a non-trial context [*see, e.g.*, Abstract, Col. 7, lines 5-15] is so different from that of Medical Experts, *i.e.*, describing a biased expert that is selected to serve the needs of the hiring attorney in a trial [Page 1 Paragraph 3] that there lacks any motivation to combine Walker with Expert Witnesses, and the Examiner does not provide such a motivation. Applicant respectfully

notes that an analysis of reasons motivating combination of references must be made explicit. *KSR Int. v. Teleflex Inc.*, 550 U.S. ____ (2007). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In this case the Examiner has failed to provide reasoning why such distinct references as Walker and Medical Experts should be combined.

Further, Medical Experts indicates that expert witnesses are not neutral independent evaluators of medical conditions and are motivated to provide non-neutral, biased testimony, stating that “the courts allow experts to step into this void with standards tailored to serve the desired ends of the lawyer engaging the expert” [Medical Experts, Page 1, Paragraph 3]. Medical Experts further states that “the testimony of expert witnesses is inevitably theater,” and consequently the “absence of standards” for judging such theater “also makes it difficult to identify impartial third parties [*i.e.* expert witnesses] to act as scientific referees” [Medical Experts, Page 3, Paragraph 6 – Page 4, Paragraph 1], thereby describing that in many, if not most, situations expert witnesses are not impartial. This is clearly opposite to and teaches away from the motivation and teachings of the present invention, which describe providing a neutral, independent and unbiased expert evaluation of a claim, outside of a trial context (*see, e.g.*, paragraphs 0005-0006 of the instant application which discusses expert biases and desire to overcome these deficiencies by use of the present invention, and paragraphs 0024-0025 which describe that the present invention is advantageous in “facilitating the settlement of valid claims before, or soon after, expensive litigation commences”).

In addition, Medical Experts fails to disclose anything regarding the specific limitations described in claim 2. The Examiner merely makes a conclusory assertion, without point to anything specific in Expert Witnesses, stating:

Medical Experts . . . discloses that an expert witness must assert familiarity with the treatment of patients with the plaintiff's complaint by physicians similarly situated to the defendant and than an expert witness may offer an opinion as to whether the defendant (i.e. physician) was qualified to treat the plaintiff's condition.

Based on this conclusory statement, the Examiner then asserts that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain facts and documents that relate to the claim and background information about the party asserting the claim (i.e. patient) and about the party against whom the claim is asserted (i.e. physician) in order for the expert to develop a conclusion as to whether based on the plaintiff's condition and the defendant's actions the defendant did not meet the standard of care and as to whether the defendant was qualified to treat the plaintiff. (emphasis added)

Based on the Examiner's arguments, Applicant believes that the Examiner is merely stating that Medical Experts describes what an expert witness is supposed to do at trial, and then argues that in order to do it the expert would need to collect all of the elements of claim 2, including those highlighted above. This is nothing more than hindsight bias and speculation, which, as the Supreme Court noted, may lead to distortion in analysis: "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant on ex post reasoning . . . [further warning against] a temptation to read into the prior art the teaching of the invention at issue." *KSR Int. v. Teleflex Inc.*, 550 U.S. ____ (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966)). Medical Experts

says nothing about any of the four above described claim elements, acquisition or distribution of these four elements by a third party, or how the Expert performs his or her analysis using these elements – in effect, the Examiner is merely reading these elements into Medical Experts in hindsight based on the Examiner's speculation as to what would be required to evaluate a claim.

Further, Applicant respectfully notes that, when applying a rejection under 35 U.S.C. § 103, the Examiner cannot rely on generally pointing to the references to support a claim that each limitation is taught as has been done in the instant Office Action. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re* Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), see also MPEP § 2143.03. Consequently, establishing that all the claim limitations are taught requires that, for references like Expert Witnesses, “the particular part relied on must be designated as nearly as practicable” by the Examiner. *See, e.g.*, Rule 1.104 (c)(2). This Office Action, however, does not show with any specificity what construct or language from Expert Witnesses corresponds to each of the four above described elements of claim 2. Without more, the Office Action has failed to meet the standard for a *prima facie* case of obviousness.

For at least the above described reasons, Applicant respectfully submits that neither Walker or Expert Witnesses, alone or in combination, describe all of the elements of claim 2, and therefore asserts that the rejection of claim 2 under 35 U.S.C. § 103 is improper. Accordingly, Applicant requests that the rejection be withdrawn and claim 2 be allowed.

With respect to claim 3, Applicant respectfully asserts that the Examiner has likewise failed to describe all of the limitations of claim 3. Specifically, the Examiner has failed to show where Expert Witnesses describes a plurality of the following types of information: (a) resumes, (b) at least one curriculum vitae, (c) educational history, (d) employment history, and (e) professional training. The Examiner has merely made a conclusory statement that it would have been obvious to one of ordinary skill in the art to obtain the claimed elements, without showing any support for such an assertion. As with the rejection of claim 2, this rejection inserts speculation and hindsight bias, and does not show with any specificity what construct or language from Expert Witnesses corresponds to each of the five above described elements of claim 3. Without more, the Office Action has failed to meet the standard for a prima facie case of obviousness.

For at least the above described reasons, Applicant respectfully submits that neither Walker or Expert Witnesses, alone or in combination, describe all of the elements of claim 3, and therefore asserts that the rejection of claim 3 under 35 U.S.C. § 103 is improper. Accordingly, Applicant requests that the rejection be withdrawn and claim 3 be allowed.

With respect to claim 4, one aspect of the present invention as is described in this claim relates to an expert evaluation step wherein the expert states, in an objective evaluation, whether there was any action or inaction by the claimant which can be attributed to or cited as the cause of the current condition, listing by symptoms and cause. The Examiner asserts that Liebig teaches such an element, Pages 9 and 10, which the Examiner states discloses:

the expert stating that due to the failure to refer the Plaintiff to a neurosurgeon, and due to the neurosurgeon not ordering an MRI, the physicians deprived the Plaintiff of an opportunity for an intervention that could have stabilized or perhaps improved the Plaintiff's condition

Applicant notes that pages 9 and 10 do describe that testimony from an expert (*i.e.*, Dr. Wilberger) states that the VA doctors involved in the case (*i.e.*, the defendants Dr. Orfei and Dr. Garman) "violated the standard of care" [Page 10, 1st full paragraph]. However, the Examiner misconstrues the relevance of this section of Liebig to the above described element of claim 4. Specifically, the above described element describes that the expert states whether there was any action/inaction by the claimant, (*i.e.*, the injured part) *not by the defendant* (*i.e.*, the care provider). In effect, the cited section of Liebig is the opposite of the claim element – claim 4 describes the expert to state actions/inactions taken by the claimant (the injured party, Susan Liebig-Grisby), not the opposing party (Doctors Garmon and Orfei). Further, Applicant is unable to find any other description in Liebig of the expert describing actions or inactions taken by the claimant, or any associated symptoms and/or causes. Liebig merely describes expert testimony related to the failure of the treating doctors to maintain the relevant standard of care. Without more, the Office Action has failed to meet the standard for a prima facie case of obviousness.

For at least the above described reasons, Applicant respectfully submits that neither Walker or Expert Witnesses, alone or in combination, describe all of the elements of claim 4, and therefore asserts that the rejection of claim 4 under 35 U.S.C. § 103 is improper. Accordingly, Applicant requests that the rejection be withdrawn and claim 4 be allowed.

With respect to claim 5, one aspect of the present invention as is described in this claim relates to an expert evaluation step wherein the expert provides, for each symptom/cause treated, both one or more arguments why the treatment met the standard of care as well as one or more arguments why each treatment did not meet the standard of care (i.e., in the form of a logical “and”). The Examiner asserts that Medical Experts teaches such elements, stating that Medical Experts:

discloses the requirement for an expert witness with the concept of the expert stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care . . . (Page 1), via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant’s conduct did or did not meet this standard (emphasis added)

Applicant notes that, although the Examiner did not refer to a specific section of Medical Experts, Page 1, Applicant believes that the Examiner is referring to the second full paragraph of Page 1 which states that “[a]n expert witness must establish a standard for medical care and give an opinion on whether the defendant’s conduct met this standard.” This is in agreement with the last two lines of the Examiner’s assertion above, stating that the expert should give an opinion on whether the treatment either did, or did not, meet the standard of care (i.e., in the logical form of “or”). However, as noted above, claim 5 requires that the expert both provide arguments as to why the treatment did meet the standard of care (along with citations) as well as arguments as to why the treatment did not meet the standard of care (along with citations). Contrary to the Examiner’s assertion, Medical experts says nothing about the expert providing both arguments – it merely

describes that, in testimony, the expert will describe whether the treatment met one or the other standard of care.

Further, Applicant is unable to find any other description in either Medical Experts or Liebig that describe or suggest an expert would provide such an objective evaluation that considers and provides such opposing arguments. As described in Medical Experts, experts are typically selected because of their bias or likelihood of providing a favorable statement to the retaining party (*see, e.g.*, Page 1, Para. 3 which describes that experts "step into the void with standards tailored to serve the desired ends of the lawyer engaging the expert"). Consequently, Medical Experts indicates that an expert is likely to be inherently biased in favor of the retaining party and therefore would not provide contrary arguments. Liebig likewise describes an expert providing a one-sided opinion that the treating physicians failed to provide the required standard of care (and says nothing about arguments as to why the standard of care was met), which is the normal practice for a testifying expert in a trial. Without more, the Office Action has failed to meet the standard for a *prima facie* case of obviousness.

For at least the above described reasons, Applicant respectfully submits that neither Walker or Expert Witnesses, alone or in combination, describe all of the elements of claim 5, and therefore asserts that the rejection of claim 5 under 35 U.S.C. § 103 is improper. Accordingly, Applicant requests that the rejection be withdrawn and claim 5 be allowed.

With respect to claims 6 and 7, these claims are dependent on, respectively, claims 4 and 5, as well as claim 1. For at least the reasons described above with respect to claims 1, 4

and 5, Applicant respectfully submits that claims 6 and 7 are also allowable. Accordingly, Applicant requests that the rejection of claims 6 and 7 be withdrawn and the claims be allowed.

New Claims

Applicant has added new claims 9-26 as fully supported by the Specification and Drawing of the present application as filed. For at least the reasons provided above with respect to claim 1-7, Applicant believes that new claims 9-26 are patentably distinguishable from the cited references, and therefore Applicant requests that new claims 9-26 also be allowed.

Concluding Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims, including any cancelled claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim except as specifically stated in this paper.

Applicant respectfully requests consideration of the remarks herein prior to further examination of the above-identified application. The undersigned would of course be

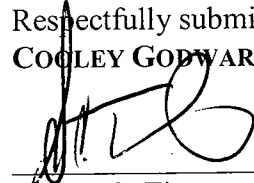
available to discuss the present application with the Examiner if, in the opinion of the Examiner, such a discussion could lead to resolution of any outstanding issues.

Dated: October 10, 2008

Cooley Godward Kronish LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

By:

Respectfully submitted,
COOLEY GODWARD KRONISH LLP



Steven C. Tietsworth
Reg. No. 59855